

**Notice Concerning Calculation of the Patent Term Adjustment under 35 U.S.C.
§ 154(b)(1)(B) involving International Applications Entering the National Stage
Pursuant to 35 U.S.C § 371**

Summary: The computer program that the United States Patent and Trademark Office (USPTO) uses to calculate patent term adjustment incorrectly calculates the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) in international applications if the requirements of 35 U.S.C. § 371 are not fulfilled on the date that the national stage commenced under 35 U.S.C. § 371(b) or (f). The USPTO is in the process of correcting this computer program. Applicants seeking a revised patent term adjustment determination based on this calculation must submit a timely request for reconsideration of the patent term adjustment indicated in the patent under 37 CFR 1.705(d).

Background: Under 35 U.S.C. § 154(b)(1)(B), an applicant is entitled to additional patent term adjustment if the issue of an original patent is delayed due to the failure of the USPTO to issue a patent within three years after the actual filing date of the application. The USPTO implemented the three-year pendency provision in 35 U.S.C. § 154(b)(1)(B) in 37 CFR 1.702(b) and 37 CFR 1.703(b). See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56391-92 (Sept. 18, 2000) (final rule). The USPTO indicated the three-year pendency provision in 35 U.S.C. § 154(b)(1)(B) is measured from the date that the national stage commences under 35 U.S.C. § 371(b) or (f) in an international application. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56382-84.

The USPTO makes patent term adjustment determinations by a computer program that uses the information recorded in the USPTO's automated patent application information system (the Patent Application Locating and Monitoring system or PALM system), except when an applicant requests reconsideration pursuant to 37 CFR 1.705. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56370, 56380-81.

Discussion: The USPTO is in the process of correcting an error in the computer program that it uses to calculate the patent term adjustment that affects patents issuing from international applications entering the national stage as to the United States pursuant to 35 U.S.C. § 371. The USPTO's computer program incorrectly calculates the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) in international applications as being measured from the date that the requirements of 35 U.S.C. § 371 were fulfilled rather than the date the national stage commenced under 35 U.S.C. § 371(b) or (f) in the international application. The USPTO is correcting the computer program to reflect that the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) in international applications is measured from the date the national stage commenced under 35 U.S.C. § 371(b) or (f) in the international application.

An applicant seeking a revised patent term adjustment determination based upon the three-year pendency provision must submit a timely request for reconsideration of the patent term adjustment indicated in the patent. The USPTO does not calculate and inform the applicant of the patent term adjustment based upon the three-year pendency

provision of 35 U.S.C. § 154(b)(1)(B) in the notice of allowance because the USPTO must know the date the patent will issue to be able to calculate the patent term adjustment based upon this provision. Thus, reconsideration of the patent term adjustment indicated in the patent as it relates to the three-year pendency provision of 35 U.S.C.

§ 154(b)(1)(B) is **not** considered a matter that could have been raised in an application for patent term adjustment under 37 CFR 1.705(b) (provides for reconsideration of the patent term adjustment indicated in the notice of allowance). Therefore, a request for reconsideration of the patent term adjustment calculation based on the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) will be considered timely under 37 CFR 1.705(d) if filed within two months of the date the patent issued.

For Further Information Contact: The Office of Patent Legal Administration by telephone at (571) 272-7702, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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